

Appl. No. 10/820,575
Office Action dated March 26, 2007.

REMARKS

The Office has required restriction between groups I, II and III (claims 19-21, 49-52, 59-60, 63, 65-69, 71-73 and 75-81, allegedly directed to the combination) and group IV (claim 64 allegedly directed to the subcombination). The Office has further required election of alleged species of group II (claims 49-52, 59, 71-73, and 78-81 allegedly directed towards a turbidity monitoring method in which the container containing the subject material is static) and group III (claim 74 allegedly directed towards a turbidity monitoring method in which the container containing the subject material is rotating). Applicant elects groups I, II and III with respect to the restriction requirement and group II of the election of species *with traverse*.

Applicants submit that the restriction and election are improper under the MPEP and in consideration of the previous numerous examinations of the claims now subject to restriction election.

Restriction Requirement

Initially, the Office relies upon MPEP 806.05(c) in support of the restriction of inventions and which states that the inventions are distinct if the combination *does not* require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness) and the subcombination can be shown to have utility either by itself or in another materially different combination.

The Office alleges that the subcombination has separate utility such as a particle counter or a particle size detector. However, these recitations appear to be the subjective opinions of the Examiner since the Office has provided no evidence in

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support of the assertions and the record is void of any support of the opinion of the Examiner. Applicant respectfully submits the restriction between groups I, II and III and group IV is improper for at least this reason and the further reasons below in consideration of the extensive prosecution of the present application up to this point.

Applicants respectfully submit that the restriction requirement is improper for at least the above-mentioned compelling reasons.

Election

According to MPEP §806.04(f) (8th ed., rev. 5), it is stated a requirement for restriction may be proper if the species are *mutually exclusive*. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species but not the first. This MPEP section also provides that to require restriction between claims limited to species, *the claims must not overlap in scope*. The claims identified by the Office have not been demonstrated to be mutually exclusive from one another and accordingly the claims are not directed towards different species for which restriction is proper. Applicant respectfully requests withdrawal of the rejection pursuant to the authority of MPEP 806.04(f).

In particular, Applicants note that claim 74 (identified as allegedly being directed to one species) depended directly from independent claim 49 (identified as allegedly being directed to another species). This relationship of claim 74 previously depending from and including all limitations of claim 49 is clear evidence that the claims overlap in scope and are not mutually exclusive and accordingly the election requirement of the

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Office is improper and contrary to the MPEP. Furthermore, Applicants respectfully submit the Office has mischaracterized Group II since claim 49 recites *providing subject material in a substantially static condition within the container* as opposed to positively defining a container containing the subject material is static as used as the reason for requiring election on page 4 of the Office Action.

Applicants respectfully request withdrawal of the requirement for election of species for at least the above-mentioned compelling reasons.

Previous Prosecution

Applicants also respectfully submit that the restriction and election are improper in consideration of the extensive prosecution of the application and the previous issuance of three substantive actions by the Office.

In view of the following prosecution history of the present application up to this point, it is clear that restriction is not proper. More specifically, Applicant notes the prosecution of the subject application has proceeded as follows:

First Office Action mailed April 21, 2005 allowing claim 64 and rejecting claims 19-21, 49-52, and 59-63.

Second Office Action mailed November 30, 2005 allowing claim 64 and rejecting claims 19-21, 49-52, 59-63 and 65-74.

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Third Office Action mailed June 16, 2006 allowing claims 19-21, 60, 63-69
and 75-77 and rejecting claims 49-52, 59, 71-73 and 78-80.

Accordingly, as set forth above, *the Office has searched and examined claims of both groups during previous prosecution.*

Applicant further refers to MPEP 808.02 (8th ed., rev. 5) entitled Establishing Burden. It is stated in such MPEP section that even if restriction is proper under MPEP §806.05 - 806.06, *the Examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden if restriction is not required. The Examiner must show by appropriate explanation one of the following: (a) separate classification, (b) separate status in the art when they are classifiable together, or (c) a different field of search. It is further stated in MPEP 808.02 that where the classification is the same and field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist dividing among related inventions.*

The restriction requirement is entirely void of identifying any indication of separate future classification or field of search. Section B of MPEP 808.02 states that separate status in the art may be shown by citing patents which are evidence of such separate status, and also separate field of search. *No patents have been cited or other evidence offered to indicate the alleged separate status. In addition no separate field of search is required inasmuch as claims of the application have been examined on the merits three times.* There is no indication that a different classification is provided or a different field of search is required. No clear indication of separate future classification

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and field of search are provided. *As mandated by MPEP 808.02, no reasons exist for dividing among related inventions.*

Applicant further contends that any restriction is improper for at least the following reasons.

First, the Examiner has apparently already searched and examined the application three times. Accordingly, now requiring elimination of any set of claims will not reduce the scope of searching, and thus there are no efficiencies gained by imposing a restriction requirement. In addition, restriction at this late time is not timely, and does not have any sense of fairness to Applicant.

Restriction is not proper since there is increased burden on the U.S. Patent and Trademark Office, on the Applicant and ultimately on the public in prosecuting multiple separate patent applications. For Applicant, splitting the invention into multiple cases increases costs associated with government fees, prosecution fees, and maintenance fees for multiple patents. For the PTO, there are increased costs associated with conducting multiple searches in multiple applications and multiple examinations for an invention that already has been searched and examined. It further ultimately produces a burden on the pertinent public that will review Applicant's commonly patented technology. Such people will be compelled to unnecessarily review multiple issued patents and file histories.

Pursuant to MPEP 803 (8th ed., rev. 5), it is stated that *if the search and examination of all the claims in an application can be made **without serious burden**, the examiner **must** examine them on the merits, even though they include claims to independent or distinct inventions.* In view of the prior three examinations of the present

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application, Applicant respectfully submits no serious burden exists and Applicant respectfully requests withdrawal of the restriction requirement for this additional reason. Restriction is not proper under MPEP 806, MPEP 808.02 and MPEP 803 in view of the extensive previous prosecution of the present application including *examination of the application three previous times on the merits*.

Applicants respectfully assert that the Examiner's restriction requirement and election is improper, and request that the Examiner withdraw the restriction requirement and consider the already examined claims in this application at this time.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 5/29/07

By: 

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